

Notice of Allowability

Application No.

10/518,543

Examiner

Yong Chu

Applicant(s)

JORAND-LEBRUN ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 7/11/2005.
2. ☒ The allowed claim(s) is/are 1-7, 9, and 13-15.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. EPO-02100784.4
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date 1/3/2005
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claims 8, 10-12, and 16 are cancelled by Examiner's Amendment with the authorization from Applicants' representative Attorney Richard Treanor on 27 April 2006. Claims 1, 3-7, 9, and 13-15 are amended by amendment filed on 3 January 2005. Therefore, claims 1-7, 9, and 13-15 are currently pending in the instant application.

Information Disclosure Statement

Applicant's Information Disclosure Statements, filed on 3 January 2005, have been considered. Please refer to Applicant's copies of the PTO-1449 submitted herewith.

Priority

This application is a 371 of PCT/EP03/50286, filed on 4 July 2003. Applicants claim the benefit of European Patent Application 02100784.4 filed on 5 July 2002, under 35 U.S.C §119 (a-d).

Response to Amendment

The Supplementary Amendment dated on 3 January 2005 has been entered.

Examiner's Amendment

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The application has been amended as follows:

Delete claim 8 of the supplementary amendment.

Delete claim 10 of the supplementary amendment.

Delete claim 11 of the supplementary amendment.

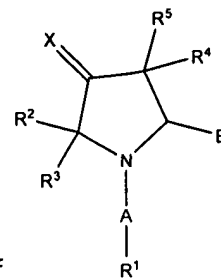
Delete claim 12 of the supplementary amendment.

Delete claim 16 of the supplementary amendment.

Reasons for Allowance

The present invention is directed to a pyrrolidine compound, a pharmaceutical composition containing the said compound and the methods to make the compounds and the method to use the compound for treating preterm labor, premature birth or dysmenorrhea. The closest prior arts of record is WO01/72705 (Halazy *et al.*) and co-pending U.S. Patent Application US2006/0004020 A1 (Schwarz).

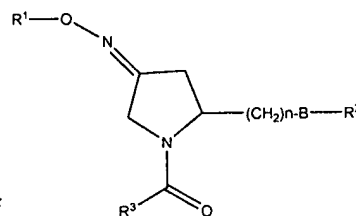
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WO01/72705 (Halazy *et al.*) discloses a group of compounds of

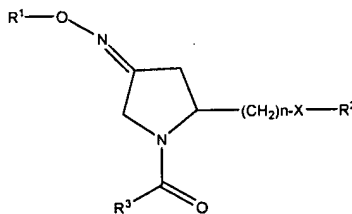
wherein B is a group of $-(C=O)-NRR'$ or a group of heterocyclic residue for the treatment of preterm labor, premature birth. This compound is related but patentably distinct to the compounds disclosed in the instant application because the substitute next to nitrogen ($-(CH_2)_n-X$ wherein X is N or O) in the instant application is different from B substitute ($-(C=O)-NRR'$ or a group of heterocyclic residue) of the prior art.

Co-pending U.S. Patent Application US2006/0004020 A1 (Schwarz) have the same assignee, as the instant application but there is no Obvious Double Patenting



found. The compound of the prior art claims a compound of

wherein **B** is $-COO$, $-CONR^4$, oxadiazole, thiadiazole or benzimidazole, which is



different from instant claimed compound

wherein **X** is O or N.

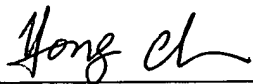
The processes to use and to make are fully enabled by the specification. Therefore, claims 1-7, 9, and 13-15 are allowed.

Telephone Inquiry

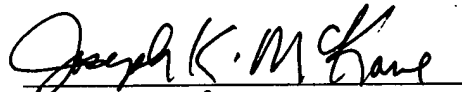
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yong Chu, Ph.D.
Patent Examiner
Art Unit 1626



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626